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09/760,113	01/12/2001	Barrett Toan	C18497/106453	1973

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EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/760,113

Applicant(s)

TOAN ET AL.

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2001 and 16 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/16/01.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the application filed 1/12/01. Claims 1-17 are pending. The IDS filed 4/16/01 has been entered and considered. Applicant's response to the Requirement for Information under 37 C.F.R. 1.105 filed 10/3/05 is also acknowledged.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It states that each inventor is the original, first, and sole inventor of identified specification. However, the declaration is signed by two individuals.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It has been held that a single claim covering both an apparatus and a method of use of that apparatus is invalid because such a claim "is not sufficiently precise to

provide competitors with an accurate determination of the 'metes and bounds' of protection involved" and is "ambiguous and properly rejected" under section 112, paragraph 2. *Ex parte Lyell*, 17 USPQ2d 1548 (BPAI 1990).

Exemplary claim 1 is vague and indefinite because it is unclear whether the Applicant seeks protection for a system and its components/elements or a method and the recited steps of claim 1. A similar analysis may be applied to claim 15, which is similarly worded.

Claims 2-11 inherit the deficiencies of claim 1 through dependency and are also rejected.

Claims 16-17 inherit the deficiencies of claim 15 through dependency and are also rejected.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, and 9-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hyman (USPN 6,092,047).

[claim 1] Hyman discloses a method for using a computer apparatus for evaluating a plurality of plan design options that can be incorporated into a benefit plan offered to a given participant population by comparing the cost of providing each option to the benefits of such option perceived by a group of one or more subjects,

- the computer apparatus comprising an input device for receiving input data, a memory device connected to the input device for storing the input data, a processor connected to the memory device which is programmed to perform operations upon the stored data to produce output data, and an output device connected to the processor for displaying the output data, (Figures 1A-B; col. 5, 31-39)

the method comprising the steps of:

- inputting the identification of the plan design options and a reference plan design option and the cost of providing each option; (Figure 2A-2B; col. 5, lines 40-59; col. 6, lines 58-65)
- providing the subject group with information about each plan design option and inquiries to elicit responses comparing each plan design option to the reference plan design option; (col. 5, lines 45-49; col. 6, lines 8-46; col. 7, lines 29-32)
- inputting data representative of the subject group responses; (col. 5, lines 45-49; col. 7, lines 54-66)
- calculating the average perceived benefit for each plan design option relative to the perceived benefit for the reference plan design option; (Figure 2B; col. 7, line 64-col. 8, line 10; col. 9, lines 30-48)

- dividing the cost of providing each option by the calculated average perceived benefit for such option; and (col. 8, lines 7-10; col. 9, lines 30-48)
- outputting the calculated data. (col. 8, lines 7-10)

[claim 2] Hyman discloses the method of claim 1 wherein the subject group is comprised of members of the participant population. (col. 8, lines 2-6)

[claim 9] Hyman discloses the method of claim 1 wherein the subject group is comprised of one participant (col. 8, lines 2-6). The preamble recites the transitional phrase/term "comprises," which "is inclusive or open-ended and does not exclude additional, unrecited elements or method steps." See MPEP 2111.03. As such, the Examiner interprets this claim to mean that the group includes "at least one participant."

[claim 10] Hyman disclose a method further comprising the step of inputting the identification of the plan design options incorporated in a given plan design (Figure 2B, col. 8, line 7- col. 9, line 55) and wherein the step of outputting the calculated data comprises identifying the output data which relate to the plan design options incorporated in the given plan design. (Figure 2B, Figures 3A-3B; col. 10, line 51-col. 11, line 48; col. 12, line 38-col. 13, line1)

[claim 11] Hyman discloses a method wherein the responses of the subject group comprise data representing each subject's assessment of a plurality of benefit criteria for each plan design option compared to the reference plan design option (Figure 2B, col. 8, line 7- col. 9, line 55) and wherein each subject's perceived benefit for each plan design option is determined according to a relative weight defined by the subject for each specific benefit criterion. (Figures 3A-3B; col. 10, line 51-col. 11, line 48; col. 12, line 38-col. 13, line 1)

[claim 12] Hyman discloses the method of claim 11 further comprising the step of inputting values for at least one statistical factor related to each plan design option (Figure 2B; col. 8, lines 7-65; Figure 3A) and wherein each subject's perceived benefit for each plan design option comprises the product of a relative weight defined by the subject to be accorded each statistical factor multiplied by the value of such statistical factor for such plan design option. (Figure 3B; col. 14, lines 28-col. 15, line 12)

[claim 13] Hyman discloses a computer based system for evaluating a plurality of plan design options that can be incorporated into a benefit plan offered to a given participant population by comparing the cost of providing each option to the benefits of such option perceived by a group of subjects, the system comprising:

- an input device for receiving input data, (Figure 1A; col. 5, lines 27-39)
- a memory device connected to the input device for storing the input data,  
(Figures 1A-B; col. 5, lines 27-39)

- a processor connected to the memory device which is programmed to perform operations upon stored data to produce output data, and (Figures 1A-B; col. 5, lines 27-39)
- an output device connected to the processor for displaying the output data (Figures 1A-B; col. 5, lines 27-39)
- the input device capable of receiving data representing the identification of the plan design options, the reference plan design option, the cost of providing each option (Figure 2A-2B; col. 5, lines 40-59; col. 6, lines 58-65) and responses of the subject group to inquiries comparing each plan design option to the reference plan design option; ( col. 5, lines 45-49; col. 7, lines 54-66)
- and the processor programmed for calculating the average perceived benefit for each plan design option relative to the perceived benefit for the reference plan design option (Figure 2B; col. 7, line 64-col. 8, line 10; col. 9, lines 30-48) and dividing the cost of providing each option by the calculated average perceived benefit for such option. (col. 8, lines 7-10; col. 9, lines 30-48)

[claim 14] Hyman discloses a method in which the group members are repeatedly surveyed to determine which whether the employees with opt down or opt out of certain benefits. (i.e. readministering inquiries to the subject group to elicit revised responses comparing each plan design option to the reference plan design option) (col. 7, lines 29-35; lines 54-59) and wherein the input device is capable device receiving this information. Hyman further discloses inputting data representing revised responses of



the subject group to the inquiries (col. 7, lines 59-63) and using this revised response data to calculate that average perceived benefit of each design option. (col. 7, lines 64-col. 8, line 6; col. 8, line 60-col. 9, line 25).

[claim 15] Hyman discloses a method for using a computer apparatus for evaluating a plurality of plan design options that can be incorporated into a benefit plan offered to a given participant population by comparing the cost of providing each option to the benefits of each option perceived by a group of one or more subjects,

the computer apparatus comprising an input device for receiving input data, a memory device connected to the input device for storing the input data, a processor connected to the memory device which is programmed to perform operations upon the stored data to produce output data, and an output device connected to the processor for displaying the output data, (Figures 1A-B; col. 5, 31-39)

the method comprising the steps of:

- inputting the identification of the plan design options, values for each of a plurality of statistical factors related to each plan design option, and the cost of providing each option, (Figure 2A-2B; col. 5, lines 40-59; col. 6, lines 8-65)
- providing the subject group with information about each statistical factor and inquiries to elicit responses providing the relative weight of each statistical factor

to be used in determining the perceived benefit of the plan design options; (col. 5, lines 45-49; col. 6, lines 8-46; col. 7, lines 29-32)

- inputting data representative of the subject group responses; (col. 5, lines 45-49; col. 6, lines 8-46; col. 7, lines 29-32)
- calculating the average perceived benefit for each plan design option; (Figure 2B; col. 7, line 64-col. 8, line 10; col. 9, lines 30-48)
- dividing the cost of providing each option by the calculated average perceived benefit for such option; (col. 8, lines 7-10; col. 9, lines 30-48)
- and outputting the calculated data. (col. 8, lines 7-10)

[claim 16] Hyman discloses a method wherein each subject's perceived benefit for each plan design option comprises the sum of the product of the relative weight accorded each statistical factor as defined by the subject's responses multiplied by the value of such statistical factor. (col. 15, lines 59-col. 16, line 58)

[claim 17] Hyman discloses a The method of claim 15 further comprising the step of inputting the identification of a reference plan design option (col. 7, lines 64-col. 8, line 10); and wherein the average perceived benefit for each plan design option is determined by comparing values of the statistical factors relating to such plan design option to the values of the statistical factors relating to the reference plan design option. (col. 9, lines 45-60)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyman.

[claims 3-4] Hyman discloses a method for allowing a user to determine the perceived benefit of a plan design option and determining the cost of benefit design options (col. 7, line 64-col. 8, line 10; col. 9, line 56-col. 10, line 4), but does not expressly disclose the units in which this information is expressed (e.g. per-patient per year costs and the average perceived benefit is expressed in terms of per-patient perceived benefit/ or per-member per year costs and per-member perceived benefit.) However, at the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Hyman to express the desired information in per-patient or per-member costs per year and per-member or per-patient perceived benefit format. One would have been motivated to present the information in this manner to facilitate an employer's ability to define and prioritize goals for a benefit plan for employees, as suggested by Hyman. (col. 4, lines 9-29)

9. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyman as applied to claim 1 above, and further in view of Warrady (USPN 6,067,522)

[claims 5-8] Hyman discloses the method of claim 1, and further discloses a method in which the group members are repeatedly surveyed to determine which whether the employees with opt down or opt out of certain benefits. (i.e. readministering inquiries to the subject group to elicit revised responses comparing each plan design option to the reference plan design option) (col. 7, lines 29-35; lines 54-59). Hyman further discloses inputting data representing revised responses of the subject group to the inquiries (col. 7, lines 59-63) and using this revised response data to calculate that average perceived benefit of each design option. (col. 7, lines 64-col. 8, line 6; col. 8, line 60-col. 9, line 25). Hyman does not expressly disclose displaying data representative of the responses to the subject group. Hyman further does not disclose soliciting comments or providing comments from subjects regarding their responses and soliciting comments from subjects regarding the validity of their responses.

Warrady discloses a system and method comprising displaying data representative of the responses to the subject group, soliciting comments or providing comments from subjects regarding their responses and soliciting comments from subjects regarding the validity of their responses. (Figure 5, col. 11, lines 1-19) The employees are given chance to review choices/ selections made regarding benefit plan decisions (in a confirmation) so that the required modifications can be made. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in

Art Unit: 3626

the art to modify the method/system of Hyman with the teaching of Warrady to display information representative of the subjects' responses and to allow the subjects to respond or provide comments regarding their responses (e.g. the validity of their responses). As suggested by Hyman, one would have been motivated to include these features to permit an employee to repetitively set and reset benefit plan goals and priorities attached to these goals to produce solutions of financial aspects, while allowing the employer to adopt the plan whose financial aspects are also best suited for the employer. (col. 4, lines 12-17)

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Lencki et al (USPN 2002/00496617) discloses a system and method for self-configured employee benefits.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*RP*  
RP



**ALEXANDER KALINOWSKI**  
**SUPERVISORY PATENT EXAMINER**